

### **REMARKS**

This Amendment is in response to the Office Action mailed on June 4, 2007, in which claims 19-23 were rejected. Applicant respectfully requests reconsideration of the present Application in view of the reasons that follow.

1. Rejection of Claims 19-21 Under 35 U.S.C. § 102(b) as Anticipated by Levisman

On page 2 of the Office Action, the Examiner rejected claims 19-21 under 35 U.S.C. § 102(b) as anticipated by Levisman, U.S. Patent No. 6,350,126. Applicant respectfully traverses the rejection.

Independent claim 19 recites “removing the shaft from the patient without removing the body or the head.” Levisman does not identically disclose a method including removing a shaft without removing the body or the head. In contrast, Levisman discloses a prosthesis wherein it is possible to remove a “stud 24” (identified as the “shaft” by the Examiner) without removing a “body 2,” but the removal of “stud 24” necessitates the removal of the “abutment 25” (identified as the “head” by the Examiner). “Abutment 25” is affixed to “stud 24,” and as such must be removed along with “stud 24.” See col. 5, lines 47-54. Therefore, Levisman does not identically disclose each of the elements of claim 19. Accordingly, independent claim 19 and corresponding dependent claims 20-21 are not anticipated under 35 U.S.C. § 102(b) and are presented for reconsideration and allowance.

2. Rejection of Claims 19-23 Under 35 U.S.C. § 103(a) Based Upon Dwyer et al.

On pages 2-3 of the Office Action, the Examiner rejected claims 19-23 under 35 U.S.C. § 103(a) as unpatentable over Dwyer et al., U.S. Patent No. 7,122,056. Independent claim 19 recites “removing the shaft from the patient without removing the body or the head.” As the Examiner recognizes on page 3 of the Office Action, Dwyer et al. does not disclose removing a shaft without removing the body (“Dwyer et al reference is silent regarding the replacement of only the shaft (12) and not of the body (14) and the distal stem element 18.” Page 3.). It would

not have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dwyer et al. to remove the “proximal neck component 12” (identified as the “shaft” by the Examiner) without removing the “sleeve component 14” (identified as the “body” by the Examiner) or the “trunnion 26” (identified as the “head” by the Examiner) because the “trunnion 26” appears to be attached to the “proximal neck component 14” and the Dwyer et al. reference provides no teaching, suggestion, or motivation to leave the body and the head in the patient while removing the shaft as specifically claimed in independent claim 19. See Figs. 2, 3, and 6.

The Examiner states that “it would have been obvious . . . to modify the shaft (12) of the implant and maintain the bore (14) and the distal stem element 18 within the bone in order to replace a damage implant.” Page 3. Regardless of whether it would have been obvious to modify Dwyer et al. to do so, claim 19 recites “removing the shaft from the patient without removing the body or the head,” which is a different concept entirely from maintaining “the bore (14) and the distal stem element 18 within the bone.”

Accordingly, independent claim 19 and corresponding dependent claims 20-23 are patentable over Dwyer et al. under 35 U.S.C. § 103(a) and are presented for reconsideration and allowance.

3. New Claims

Applicant has added new claims 42-75. The claims are supported by the specification, as filed and substantially match the scope of former claims 1-18 and 24-41, which were cancelled without prejudice in Applicant’s amendment filed March 20, 2007 in favor of claims 19-23, which were allowed. Applicant respectfully requests consideration and allowance of new claims 42-75.

4. Conclusion

Claims 19-23 and 42-75 are now pending in the present application. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application, as amended, is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date September 4, 2007

By /Jeffrey S. Gundersen/

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5897  
Facsimile: (414) 297-4900

Jeffrey S. Gundersen  
Attorney for Applicant  
Registration No. 47,619